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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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20
EXAMINER

DRODGE, JOSEPH W

ART UNIT

PAPER NUMBER

1723

DATE MAILED: 08/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/518,342

Applicant(s)

HUSEK, PETR

Examiner

Joseph W. Drodge

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2003 and 10 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 33-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 33-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 10 July 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 17.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6, 8-13, 33-39, 43-52 and 54 are rejected under 35 U.S.C. 102(e) as being anticipated by Kopaciewicz et al patent 6,048,457.

Kopaciewicz et al disclose apparatus and method for its use comprising a tapering pipette tip (figures 2A, 3A, and 3B and corresponding text) that includes an opening free of a porous barrier, filter or frit in its vicinity (column 5, lines 30-34), sorbent material that may be particulate (column 4, lines 33-36) and porous barrier, filter or frit above the sorbent material to prevent passage of particles therefrom (column 5, line 35 and column 10, lines 52-54, etc.) as required by independent claims 1, 8, 33, 35, 46, 51, 52 and 54.

Kopaciewicz et al further disclose: one of manual suction or a suction device that may comprise a plunger and setter in column 7, lines 40-42 and column 8, lines 53-55 as required in claims 2, 3 and 34; varied tip opening size relative to sorbent particle size in column 6, lines 1-9 and 28-34 as required in claims 4, 11 and 15; initial drawing of a solvent and material to form the sorbent material in column 5, lines 45-50 as required in claim 5; the sorbent material having a sticky coating as described as a binder in column 4, lines 35-37 and 50-52 as required in claims 6, 13 and 39; second pipette opening

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shown in figure 3A as required by claim 9; the tip optionally having a frustoconical or conical shape as inherent from discussion of varied shape in column 2, lines 54-57 as required in claims 10, 37, 49 and 50; drawing of fluids through the pipette while in use at column 7, lines 35-45 as required by claim 12; the cavity walls optionally forming a lip to retain the sorbent material at column 6, lines 36-40 as required by claim 36; the sorbent substantially filling the pipette cavity volume dependent upon selection of particle and pipette size at column 5, lines 30-34 as required in claims 38, 43, 48 and 51 and optional cap at the openings mainly shown by figures 3A and 3B.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 7, 14, 40-42, 53 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kopaciewicz et al in view of Monsour patent 6,057,165.

These claims differ in requiring the binder to comprise a material selected from the group consisting of propylene or ethylene glycol or glycerol. Such binder in a body of

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adsorbent material used in assay laboratory apparatus is taught by Monsour at column 7, lines 43-59. It would have been obvious to one of ordinary skill in the art to have modified the adsorbent material disclosed by Kopaciewicz et al which is disclosed as comprising any appropriate binder with the specific binder material of glycerol, as taught by Monsour in order to prevent non-specific binding that may result in false positives in assays performed with the apparatus.

Applicant's arguments with respect to claims 1-14 and 33-55 have been considered but are moot in view of the new ground(s) of rejection.

The new grounds were necessitated by adding of a new limitation to each of the independent claims concerning there not being a porous barrier or filter between the adsorbent material and opening or specifically at the opening.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Brewer patent 6,566,145; Rampal et al patent 5,437,979 and Avakian patent 3,985,032 are all of interest with respect to pipette tips having adsorbent material and porous retainers.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Joseph W. Drodge whose telephone number is (703) 308-0403. The examiner can normally be reached on Monday-Friday from approximately 8:30 AM- 4:45 PM.

JWD

July 30, 2003


JOSEPH DRODGE
PRIMARY EXAMINER